



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/903,331 | 07/11/2001 | Linda Bilsing | 10010683-1 | 8428 |

7590

08/09/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

| |
|----------|
| EXAMINER |
|----------|

HAILU, TADESSE

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2173

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/903,331 | Applicant(s) BILSING ET AL. | |
| | Examiner Tadesse Hailu | Art Unit 2173 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-9,22-25,27,28 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-9,22-25,27,28 and 32-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

PD

DETAILED ACTION

1. This Office Action is in response to the AMENDMENT entered on June 27, 2005 for the patent application number (09/903,331), filed on July 11, 2001.

Declaration under C.F.R. 1.131

2. The Declaration filed on June 27, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Chen et al (U.S. Pub. No. 2002/0033974 A1) reference. The Applicant's declaration fails to provide conception of the invention prior to the date of March 7, 2001 (the filing date for Chen et al). Regarding proof of conception date, the declaration discloses a statement that the inventors conceived the subject matter of the '331 application at least as early as April 30, 2001. Accordingly, the applicant fails to provide conception or a reduction to practice prior to the critical date of Chen et al (i.e., March 9, 2001). The Applicant's statement regarding Taiwan not being a signatory member of PCT has nothing to do with the critical date of Chen et al. (i.e., March 9, 2001 which is a US filing date).

Status of the claimed invention

3. The pending claims 2, 4, 6-9, 22-25, 27-28, and 32-37 are examined herein as follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2173

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 2, 4, 6-9, 22-25, 27-28, and 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al (U.S. Pub. No. 2002/0033974 A1).

Similar to the current invention, Chen et al (Chen) relates to an input apparatus and method in a scanner that provides at least one composite button accompanied with friendly graphic interfaces to facilitate individual to intuitively enable functions such as scanning or activating associated applications for editing scanned images (Chen, Field of the Invention). Chen also teaches the claimed invention as follows.

With regard to claim 22:

Chen discloses a computer system (10) ("imaging system") (Chen, Fig. 1A).

The computer system (10) comprising a plurality of modules including in part a scan resident module (114) ("an intent-based image acquisition system") configured to provide a selectable command or button (142, 144, 146, 148 or 150) ("intent-based selections") (e.g., a scan button (SCAN) 142, a copy button (COPY) 144, a composite button (FCN) 146, an Internet communication button (WEB) 148, and a button for scan and then activating associated applications (SCAN-TO-AP) 150) to a user and receive digital image data corresponding to a captured image (Chen, paragraphs 24 and 27).

The computer system (10) also includes a scanner (12) ("an image-capturing device") communicatively coupled to said scan resident module "intent-based image acquisition system" within the computer system 10 (Chen, Fig. 1A).

Chen further discloses that the computer system (**10**) further includes at least in response to the user selecting one of the selectable commands ("intent-based selections"), the image-capturing device captures an image as digital image data in a format corresponding to the one of the intent-based selections (Chen, paragraphs 20, 24, 25 and 27).

Chen further discloses that said scan resident module (**114**) ("intent-based image acquisition system") is further configured to enable modification of said format responsive to a user input such that the format at which the image is captured is modifiable by the user (Chen, paragraphs 6, 7, 24 and 27).

With regard to claim 25:

Chen discloses a method (Fig. 4) for providing image data to a user.

The method further includes providing selectable command or button (**142, 144, 146, 148 or 150**) ("intent-based selections") (e.g., (e.g., a scan button (SCAN) 142, a copy button (COPY) 144, a composite button (FCN) 146, an Internet communication button (WEB) 148, and a button for scan and then activating associated applications (SCAN-TO-AP) 150) to the user, each of the user selection operation command ("intent-based selections" associated with an intended use of digital image data corresponding to a captured image (Chen, paragraphs 24 and 27).

Chen further discloses in response to the user selecting one of the intent-based selections, capturing digital image data in a format corresponding to the one of the intent-based selections (Chen, paragraphs 7, 20 and 25).

Chen further discloses in response to a user input, modifying the format at which digital image data is to be captured in response to the user selecting the one of the selectable commands ("intent-based selections") (e.g., a scan button (SCAN) 142, a copy button (COPY) 144, a composite button (FCN) 146, an Internet communication button (WEB) 148, or a button for scan and then activating associated applications (SCAN-TO-AP) 150) (Chen, paragraphs 20 and 24).

Chen further discloses that the selectable commands or buttons (**142, 144, 146, 148 and 150**) ("intent-based selections") or ("intent-based actuator") are provided to the user in response to actuation of an input command or selectable command button (**e.g., 142, 144, 146, 148 or 150** located on the input device 122 of the scanner (**12**) or an image-capturing device. For example, selecting the SCAN 142 button results in displaying a graphical interface shown in Fig. 3A, selecting the Fax 144 button results in displaying a graphical interface shown in Fig. 3B, and selecting FCN (composite) 146 button results in displaying a graphical interface shown in Fig. 3C.

With regard to claim 32:

Chen discloses a computer system (**10**). The computer system (**10**) includes a plurality of modules including a scan resident module (**114**) ('an intent-based image acquisition system') configured to provide selectable command ("intent-based selections") (e.g., SCAN 142 button, Fax 144 button, and FCN (composite) 146 button, etc) to a user and receive digital image data corresponding to a captured image (Chen, paragraphs 20, 24, and 27).

The computer system also includes a scanner (12) an image-capturing device communicatively coupled to said intent-based image acquisition system (Fig. 1A).

Chen further discloses that said image-capturing device has an intent-based image acquisition system actuator (e.g., 142, 144, 146, 148 or 150 located on the input device 122 of the scanner (12)) such that, in response to actuating said intent-based image acquisition system actuator, said intent-based image acquisition system provides the intent-based selections to the user (Chen, paragraphs 20 and 24).

With regard to claim 2:

Chen also discloses that said scan resident module 114 ("intent-based image acquisition system") is configured to provide the user with a graphical user interface (e.g., Figs. 3A-3C), said graphical user interface being configured to display to the user the intent-based selections (Chen, paragraphs 20, 24, 25 and 27).

With regard to claim 4:

Chen also discloses that a selecting of one of the buttons (e.g., 142, 144, 146, 148, and 150) ("intent-based selections") is configured with format settings adapted to alter digital image data corresponding to a first intended use of the image data, and wherein said intent-based image acquisition system is further configured to enable modification of said format settings (Chen, paragraphs 7, 20, 24, 25 and 27).

With regard to claim 5:

Chen also discloses that said graphical user interface (Figs. 3A-3C) is configured to enable a user to preview image data that has been formatted to correspond to an intended use of the digital image data.

With regard to claim 6:

Chen further discloses that said selectable commands or buttons (e.g., SCAN 142 button, Fax 144 button, and FCN (composite) 146 button, etc) ("intent-based selections") are selected from the group consisting of: posting the image data on a Web site for printing, posting the image data on a Web site for viewing, emailing photo for printing, emailing photo for viewing, and archiving image data (Chen, paragraphs 20, 24 and 25 also Chen's claim 3).

With regard to claim 7:

Chen also discloses that said image-capturing device is selected from the group consisting of: a scanner, a digital camera, a multi-function device, a digital sender, and a digital copier (Fig. 1A).

With regard to claim 8:

Chen also discloses that said scan resident module ("intent-based image acquisition system") is configured to launch an application, the application being configured to enable modification of the digital image data (Chen, paragraphs 26 and 27, also Chen's claim 3).

With regard to claim 9:

Chen also discloses that said scan resident module ("intent-based image acquisition system") further comprises: means for enabling modification of the digital image data (Chen, paragraph 27).

With regard to claim 23:

Chen also discloses that said image-capturing device has an selectable buttons ("intent-based image acquisition system actuator") such that, in response to actuating said ("intent-based image acquisition system actuator,") (e.g., selecting one of the buttons **142, 14, 146, 148** or **150**), said scan resident module ("intent-based image acquisition system") provides the selectable command ("intent-based selections") to the user. For example, selecting the SCAN 142 button from the scanner results in displaying a graphical interface shown in Fig. 3A, selecting the Fax 144 button from the scanner results in displaying a graphical interface shown in Fig. 3B, and selecting FCN (composite) 146 button from the scanner results in displaying a graphical interface shown in Fig. 3C (Chen, paragraphs 20 and 27).

With regard to claim 24:

Chen also discloses that modification of the format of the digital image data comprises modification of a resolution (e.g., a scan resolution) at which the digital image data is acquired (Chen, paragraph 24).

With regard to claim 27:

Chen also discloses that modifying the format comprises modifying a resolution at which the digital image data is acquired (Chen, paragraph 24).

With regard to claim 28:

Chen also discloses that said modifying the digital image data after the digital image data has been acquired (Chen, paragraph 25).

With regard to claim 33:

Chen also discloses that in response to the user selecting one of the selectable commands or buttons (142, 144, etc) ("intent-based selections"), the image-capturing device captures an image as digital image data in a format corresponding to the one of the intent-based selections (Chen, paragraphs 20 and 24).

With regard to claim 34:

Chen also discloses that said scan resident module ("intent-based image acquisition system") is further configured to enable modification of said format responsive to a user input such that the format at which the image is captured is modifiable by the user (Chen, paragraphs 24 and 27).

With regard to claim 35:

Chen also discloses that said modification of the format of the digital image data comprises modification of a resolution (e.g., scan resolution) at which the digital image data is acquired (Chen, paragraph 24).

With regard to claim 36:

Chen also discloses that said selectable commands or buttons ("intent-based selections") are selected from the group consisting of posting the image data on a Web site for printing, posting the image data on a Web site for viewing, emailing photo for printing, emailing photo for viewing, and archiving image data (Chen, paragraphs 20, 24 and 25 also Chen's claim 3).

With regard to claim 37:

Chen also discloses that said scanner (12) image-capturing device is used to capture the digital image data (Chen, paragraph 22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (U.S. Pub. No. 2002/0033974 A1) in view of Os et al (U.S. Pat. No. 6,480,304).

While Chen discloses a graphical user interface (Fig. 3A-3C) including at least a plurality of buttons and captured or scanned image, but Chen does not clearly describe the graphical user interface is configured to enable to a user to preview the image. However, Os discloses a scanning system comprising a preview window, wherein the scanned image is displayed on a preview window 109 with a scaled page boundary of the selected page size overlaid on the scanned image (column 9, lines 5-20).

Chen and Os are analogous art because they are from the same field of endeavor, scanning system.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide the graphical user interface of Chen with preview window of Os because as suggested by OS, the preview window will help user determine to quickly review the scanned image and adjust the scanned image according to the desired or selected page size (Os, column 9, lines 5-20).

Therefore, it would have been obvious to combine Chen with Os to obtain the invention as specified in claim 5.

CONCLUSION

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:30 – 7:00 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 272-4048 Art Unit 2173.

8. An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Examiner Tadesse Hailu
Art Unit 2173
8/3/05

